



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/658,943

09/10/2003

Nicholas Simons

MSFT120206

3530

26389 7590 02/11/2008
CHRISTENSEN, O'CONNOR, JOHNSON, KINDNESS, PLLC
1420 FIFTH AVENUE
SUITE 2800
SEATTLE, WA 98101-2347

EXAMINER

TERMANINI, SAMIR

ART UNIT

PAPER NUMBER

2178

MAIL DATE

DELIVERY MODE

02/11/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	<p>Application No. 10/658,943</p>	<p>Applicant(s) SIMONS ET AL.</p>	
	<p>Examiner Samir Termanini</p>	<p>Art Unit 2178</p>	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 06 December 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

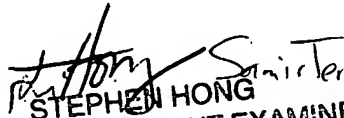
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Attached.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.


STEPHEN HONG
SUPERVISORY PATENT EXAMINER

Applicants, by way of Remark (On pg. 7, dated 6/7/2007) stated:

[a]pplicants respectfully submit that the finality of the Office Action was premature and request that the finality be withdrawn if this application is not allowed as a result of this submission.

For the detailed reasons set forth below, Applicants' assertion that the Examiner introduced a new ground of rejection not necessitated by Applicants' amendment to the claims is untenable.

After receiving a first non-final office action (dated 3/8/2007) Applicants amended each and every independent claim to add the following limitations: (1) that generating occurs "without user input"; (2) the featured content item have information focused on a specific topic; and (3) that the display of the content item occurs "without user input." Applicants stated that,

While applicants respectfully disagree with the rejection of Claims 1-12, 14-18, and 20-23 under 35 U.S.C. § 102(b), in order to advance the prosecution of this application minor clarifying amendments have been made to independent Claims 1, 14 and 20. Applicants respectfully submit that the claims are clearly allowable in view of the teachings of Barth et al.

Regardless, Applicants purpose in amending is clear – it is to overcome the 35 U.S.C. § 102(b) rejections to with which they have respectfully disagreed. Apparently, for the reason that the new limitations changed the scope of each and every independent claim, Applicants response was predominately focused on the newly added claim language - pointing out how the their new claim limitations differ from the applied reference (See Applicant's Remarks dated 6/7/2007).

In response, the Examiner agreed with Applicants in that the new limitations added, and extensively remarked to, appeared to distinguish from the cited reference. Thereafter, the Examiner conducted a new search, unfortunately found a new reference, and applied new rejections therewith.

Applicants now complain that the "[f]inality of the Office Action was premature..." because "[r]elatively minor amendments resulted in the citation of an entirely new reference and an entirely new rejection in the Office Action." In other words, Applicants take the position that when an amendment to the claims is relatively minor, it is improper for the examiner to make a second Office Action final, if new grounds of rejection are introduced. Applicants further cite M.P.E.P. 706.07(a) in support of their position.

As an initial matter, Applicants categorical characterization of the their amendments for being *minor* adds nothing to the inquiry, under M.P.E.P. 706.07(a). This is because even a *minor* change to a claim's language can dramatically change its scope. Instead, the relevant focus of the inquiry is whether the new grounds of rejection were "...necessitated by Applicants amendment to the claims..." It is for this reason, that the Examiner used a new reference in addressing the new claim language.

For the foregoing reasons the examiner respectfully submits that all new grounds of rejection were "...necessitated by Applicants amendment to the claims..." as set forth under M.P.E.P. 706.07(a).

Applicants' Remark (On pg. 4, dated 6/7/2007) states,

While Yennaco describes the use of a registry, the registry is not a system registry. Rather, it is a registry stored in cache that includes data identifiers.

In response to Applicant's argument that "the registry is not a system registry," a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

The remainder of Applicants' arguments are not persuasive for reasons already made of record.